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REMARKS

Claims 1, 2, 5, 7-15, 17, 18, 38, and 39 are currently pending and under consideration. Claim 6 has been cancelled without prejudice or disclaimer. Favorable reconsideration of the subject application is respectfully requested in view of the following comments.

I. Rejection of Claim 6 Under 37 CFR §1.75(c)

Claim 6 stands rejected under 37 CFR §1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Withdrawal of the rejection is respectfully requested for at least the following reasons. Claim 6 has been cancelled without prejudice or disclaimer, thereby rendering the rejection moot. Therefore, Applicants respectfully request withdrawal of the rejection.

II. Rejections of Claims 1, 2, 5, 6, 7, 9, 17, 18, 38, and 39 Under 35 U.S.C. §102(b)

Claims 1, 2, 5, 6, 7, 9, 17, 18, 38, and 39 stand rejected under 35 U.S.C. §102(b) as being anticipated by Griffin, *et al.* (U.S. 4,696,706). Withdrawal of the rejection is respectfully requested for at least the following reasons.

For a prior art reference to anticipate, 35 U.S.C. §102 requires that each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *See In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (*quoting Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). AIn addition, the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention. *See In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

The present invention describes a surface cover comprising among other things, two or more leaves Y arranged to form a stack of leaves, the stack of leaves comprising at least a first leaf and a base leaf underlying the first leaf. It is apparent from the specification as well as the claim language that the stack of leaves including the base leaf, the first leaf as well as the intermediate leaf, are made of the same material. In addition, the base leaf and the first leaf can serve as the outer surface of the surface cover. For example, claims 1, 18 and 38 describe that the first leaf forms an outer surface (to the surface cover or stack of leaves) and the base leaf is adapted to serve as the outer surface. This

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means that the base leaf is functionally equivalent to the other leaves (e.g., first leaf, intermediate leaf). That is, the first leaf and the base leaf both have an outer surface and together are arranged to form part of the stack of leaves. Furthermore, the specification inherently implies, if not explicitly describes, that the base leaf as well as the other leaves are made of the same material and thus, can perform the function of serving as an outer surface of the surface cover (e.g., p. 2, third paragraph; p. 4, bottom paragraph; p. 5, bottom paragraph).

Unlike the present invention, Griffin *et al.* discloses a plurality of self-adhesive logic symbols which are applied to a firm dispenser board. According to Griffin *et al.*, it is apparent that the dispenser board merely serves as a foundation from which a variety of logic symbols may be taken in order to facilitate computer program flowchart development and circuit design drawings. Furthermore, Griffin *et al.* describes a firm dispenser board whereas the material of the leaves, including the base leaf, is a flexible material, as described in the present invention and particularly, in claim 7. Thus, the dispenser board of Griffin *et al.* is not equivalent to the base leaf as described in the present invention.

The Office Action contends that the dispenser board has a greater thickness than the symbols. Although it appears that the dispenser board is thicker than the individual logic symbols formed thereon, the dispenser board is not equivalent to the base leaf of the present invention, as discussed above. In fact, Griffin fails to teach or suggest a base symbol which has a greater thickness than the other symbols formed thereon. Therefore, Griffin *et al.* fails to recite each and every element of the claimed invention. Hence, the present invention as described in the claims does not anticipate Griffin *et al.*

In view of the foregoing, withdrawal of the rejections to claims 1, 18, and 38 and claims 2, 5, 7, 9, 17 and 39, which depend therefrom is respectfully requested.

III. Rejection of Claims 8, 10, 11, and 12 Under 35 U.S.C. §103(a)

Claims 8, 10, 11, and 12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Griffin, *et al.* (U.S. 4,696,706) in view of Cleef (U.S. 2,248,317). Withdrawal of the rejection is respectfully requested for at least the following reasons. Claims 8 and 10-12 depend from independent claim 1. For the reasons set forth above with respect to claim 1, Griffin *et al.* and Cleef either alone or in combination fail to teach or suggest the elements as recited in claim 1. Therefore

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withdrawal of the rejection with respect to claims 8 and 10-12 is respectfully requested.

IV. Rejection of Claims 13-15 Under 35 U.S.C. §103(a)

Claims 13-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Griffin, *et al.* (US 4,696,706) in view of Cleef (U.S. 2,248,317) as applied to claims 8, 10, 11, and 12 above, and further in view of Bowskill, *et al.* (U.S. 4,795,669). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Claims 13-15 depend from claim 1. For the reasons set forth above with respect to claim 1, Griffin *et al.* and Cleef either alone or in combination fail to teach or suggest the elements as described in claim 1. Thus, withdrawal of the rejection as to claims 13-15 is respectfully requested.


V. Conclusion

The present application is believed to be in condition for allowance in view of the above amendments and comments.

If any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,
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MARKED UP VERSION OF AMENDED CLAIMS

✓
Please cancel claim 6 without prejudice or disclaimer.

No claim amendments have been made herein.